



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,705	06/24/2003	Yoshiki Sugeta	2003_0868A	7523

513 7590 05/19/2005

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

SASTRI, SATYA B

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,705

Applicant(s)

SUGETA ET AL.

Examiner

Satya B. Sastri

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to amendment filed on March 11, 2005. *Claims 1-11* are now pending in the application with *claims 8 and 9* drawn to a non-elected invention.

2. Applicant's amendment filed on March 11, 2005 has been fully considered with the following results. In view of the arguments, rejection of *claims 1-7* under 35 U.S.C. 102(b) as anticipated by Whitbourne (US 5,001,009) is withdrawn and rejection of *claims 1, 2, 5, 6* under 35 U.S.C. 102(b) as anticipated by Miller et al. (US 5,300,394) is also withdrawn. However, rejection of *claims 1-7* under 35 U.S.C. 102(b) as anticipated by Nishi et al. (US 5,611,850) is sustained and rejection of *claims 1, 4, 5* under 35 U.S.C. 102(b) as anticipated by Ishibashi et al. (US 5,554,489) is also sustained.

Allowable Subject Matter

3. *Claims 10 and 11* are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Instant claims recite an over-coating agent containing a water-soluble polymer, a water-soluble fluorine compound and a water-soluble amine. Prior art does not teach or suggest the use of water-soluble amine in the coating compositions applied on photoresist layers.

Response to Arguments

4. Instant claims are directed to an over-coating agent containing water-soluble polymer and a water-soluble fluorine compound. The prior art to Nishi et al. Ishibashi et al. concern antireflective compositions applied over photoresist layers for fine resist patterns. Such antireflective coatings are subsequently removed substantially and may be subjected to post-exposure baking (column 6, lines 26-51).

5. As stated in paragraph 3 of the earlier office action, the preamble with the process steps is not given patentable weight and the over-coating agent containing water-soluble polymer and a water-soluble fluorine compound is treated as a composition claim. The over-coating agent as claimed instantly reads on prior art antireflective compositions that are fully capable of the recited thermal shrinkage under heat.

6. If the preamble were to be given patentable weight as implied in applicants' arguments, then it would potentially raise the issue of hybrid claim. A single claim that claims both an agent and the method steps of using it is indefinite under 35 U.S.C. 112, second paragraph. See Ex Parte Lyell, 17 USPQ 2d 1548 (Bd. Pat. App. 7 Inter.1990). Such claims would also be rejected under 35 USC 101, because the claim embraces or overlaps two different statutory inventions.

Action Is Final

Art Unit: 1713

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

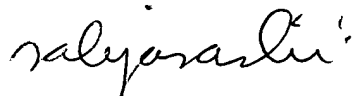
Future Correspondence

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri whose telephone number is 571-272-1112.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications. The unofficial direct fax phone number to the Examiner's desk is 571-273-1112.

Art Unit: 1713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SATYA SASTRI

May 2, 2005

TATYANA ZALUKAEVA
PRIMARY EXAMINER

